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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,274	11/04/2003	Carmo Ribeiro	71024-405	7027

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EXAMINER

HOANG, TU BA

ART UNIT PAPER NUMBER

3742

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/701,274	Applicant(s) RIBEIRO ET AL.	
	Examiner Tu Ba Hoang	Art Unit 3742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-15, 17, 18, 22-25, 27 and 28 is/are allowed.
- 6) ☒ Claim(s) 16, 19-21, 26 and 29-39 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/04/03</u> . | 6) <input type="checkbox"/> Other: ____ |

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Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16, 19-21, 26, and 31-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 16, there is a missing text between "in" and "portion" recited at line 2. The phrase "the first" should be inserted therebetween.

In claim 19, there is insufficient antecedent basis for "the joining surface on mating wall sections" recited at lines 1-2 in the claim or from the preceding claim 1. The term "portion" recited at line 2 should be in plural form (i.e., "portions").

In claim 26, the phrase "first portions" recited at line 3 should be "first portion" instead (i.e., singular form).

In claim 31, the term "position" recited at line 2 is misspelled. It should be "piston" instead.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 29-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Jarrett et al (US 6,112,642) cited by the Applicants. Jarrett et al shows all of the claimed features including a piston 30 shown in Figure 4 which comprises an upper piston portion or head member 42 having mating surfaces and a lower piston portion or skirt member 44 having mating surfaces, an annular cooling gallery, and an induction weld joint (column 6, line 1, i.e., "brazing weld"), wherein the upper and lower piston portions have radially spaced walls, the upper piston portion includes a combustion bond, a plurality of ring grooves, and valve pockets as shown in Figures 3 and 4, the lower piston portion includes spaced pin bosses, a piston skirt as shown in Figures 2 and 4, and the upper and lower piston portions can be fabricated of the same or different materials such as steel by a forging process or as an alternative, a casting process (i.e., with one of the piston portions is cast and the other is forged) as set forth at column 5, lines 31-63.

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Claims 29-30 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Foster et al (US 6,736,305). See Figures 3 and 5.

Claims 1-15, 17-18, 22-25, 27-28 are allowed.

Claims 16, 19-21, and 26 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

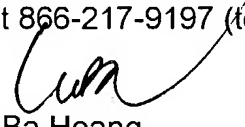
The following is a statement of reasons for the indication of allowable subject matter: the prior art of record does not show or fairly suggest a method of making or fabricating a piston, in which the mating surfaces of the first portion and the second portion to be welded or joined are spaced from one to another and are heated to a temperature sufficient for welding while being spaced apart from each other and then are brought into contact with one another to weld the portions across the joined mating surfaces in the manner recited in claims 1 and 27.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Nomura et al (US 6,222,150), Wohrstein (US 5,549,335), and Ribeiro et al (US 2002/0046593 A1).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tu Ba Hoang whose telephone number is (703) 308-3303. The examiner can normally be reached on Mon-Fri from 8:30AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tu Ba Hoang
Primary Examiner
Art Unit 3742

June 28, 2004